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12:00pm From-PILLSBURY WINTHROP SHAW PITTMAN LLP

858 509 4010

T-949 P.010/014 F-578

KEESE ET AL. - 10/656,002

Attorney Docket: 044182-0305880

IN THE DRAWINGS:

The attached sheet of drawings include changes to FIGs. 4A-4C. Replacement sheets for the original sheet are provided.

Attachment: Replacement Sheets.

REESE ET AL. - 10/656,002
Attorney Docket: 044182-0305880

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REMARKS

In the Office Action the drawings are objected to due to informality issues. Corrected drawing sheets are required. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1, 2, 4-7, 9, 12-15, 17, 19 and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,262,991 to Wagener et al. ("Wagener"). Claims 8, 16 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wagener in view of U.S. Patent 5,900,708 to Den Engelse et al. ("Den Engelse"). Applicants provide the following remarks supplemental to the arguments presented in response to the prior Office Actions.

The Drawings And Specification

In the Office Action, the Examiner objects to the appearance of reference numeral "112" at multiple locations. Applicants presume the Examiner is actually referring to reference numeral "412" and have amended the drawings accordingly. In amended Fig 4A, numeral 412 is replaced with 412a, in amended Fig 4B, numeral 412 is replaced with 412b and in amended Fig 4C, two occurrences of numeral 412 are replaced with a single 412c. In view of these drawing amendments, the Specification has been amended to provide proper identification of elements using reference numerals 412a, 412b and 412c.

The §102 Rejections

In rejecting the claims, the Examiner does not show all elements arranged as recited in the claims and does not respect the significance of all recited elements. The Office Action alleges that Wagener anticipates each and every element of claims 1-2, 4-7, 9, 12-15, 12 and 19-20. Applicants respectfully disagree. A cited prior art reference anticipates a claimed invention under 35 U.S.C. §102 only if every element of the claimed invention is identically shown in the single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990). Each and every limitation of the claimed invention is significant and must be found in the single cited prior art reference. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985). As set forth more fully below, Wagener does not disclose each and every element of the claims arranged as they are in the claims. Furthermore, the Office Action appears to dismiss the significance of certain claim elements.

REESE ET AL. - 10/656,002
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Claim 1 of the present Application requires a fixed portion configured and operative to be attached to a precision stage, a movable portion operably coupled to said fixed portion and selectively movable relative thereto, a securing mechanism configured and operative to secure a substrate at a predetermined location relative to said movable portion and an actuator mechanism operative to provide movement of said movable portion relative to said fixed portion. Wagener does not teach a fixed portion, a precision stage and a movable portion and the Office Action provides no citation to any drawing or description that shows all three of these elements. Instead, the rejections are based on redefinition and rearrangement of Wagener's elements.

Specifically, the Examiner cites a base plate, a fixed part 9 and a stage plate 1 as supposedly showing the required precision stage, fixed portion and movable portion, *respectively*. However, the Office Action does not, and cannot, show a base plate separate and distinct from fixed part 9. This failure is evident from the failure of the Office Action to cite a base plate in the drawings or written description. The base plate relied upon by the Examiner is mentioned in the Abstract and in claim 4 of Wagener and is a term that is interchangeable with fixed portion 9. This can be seen by comparing claim 1 and claim 4 of Wagener: claim 1 recites a fixed part, while claim 4 recites a base plate adapted for fixed mounting. Nothing in Wagener teaches or suggests a base plate that is anything other than fixed part 9.

Furthermore, in rejecting the claims, the Examiner omitted proper identification of Wagener's stage plate 1. It is apparent that this omission was necessary because, if Wagener's stage plate 1 was cited as teaching the required precision stage, then it would have been impossible to maintain the §102 rejection using a fictional separate base plate as teaching the required movable portion, particularly where the base plate is neither described in the Wagener written description nor depicted in any Wagener drawing.

Therefore, Wagener cannot be said to disclose each and every element of the claims arranged as they are in the claims and the rejections should be withdrawn. Furthermore, each of claims 2, 4-7, 9, 12-15, 17, 19 and 20 are allowable for at least the reasons that claim 1 is allowable. Consequently, the §102 rejections of these claims should also be withdrawn.

REESE ET AL. - 10/656,002

Attorney Docket: 044182-0305880

The §103 Rejections


Regarding claims 8, 16 and 18, Den Engelse does not cure the deficiencies of Wagener. Consequently, claims 8, 16 and 18 are allowable for at least the reason that the base claims from which they depend are allowable.

The Allowable Subject Matter

Applicants thank the Examiner for acknowledging the allowable subject matter in claims 10 and 11. Applicants believe that the base claims from which claims 10 and 11 depend are also allowable and therefore opt not to amend the claims at this time.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
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